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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,189	06/13/2001	Yoshitaka Terasaki	109768	4046

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EXAMINER	
SORRELL, ERON J	

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/879,189	TERASAKI ET AL.	
	Examiner	Art Unit	
	Eron J Sorrell	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10,12-19,21 and 23-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10,12-19,21 and 23-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 September 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *20040831*.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/6/04 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumpf (U.S. Patent No. 6,581,098).

1. Referring to claim 1, Kumpf teaches an image input and output control apparatus comprising:

a first transmitting and receiving section that transmits and receives data to and from an image input and output apparatus that performs image input and output (see lines 9-24 of column 2 and item labeled 20 in figure 2);

a second transmitting and receiving section that transmits and receives at least two of print data, scan data, and fax data to and from an information terminal apparatus that stores data to be handled by the image input and output apparatus in performing input or output (see lines 11-14 of column 1, lines 9-24 of column 2, and item labeled 18 in figure 2); and

a control section that causes data received by one of the first transmitting and receiving section and the second transmitting and receiving section to be transmitted from the other (see lines 9-24 of column 2 and item labeled 24 in figure 2); and

a storage section that stores the data received by one of the first transmitting and receiving section and the second transmitting and receiving section (see lines 25-38 of column 4).

2. Referring to claim 4, Kumpf teaches an image input and output system comprising:

an image input and output apparatus that performs image input and output (see lines 36-41 of column 2 and figure 3);

an information terminal apparatus that stores data to be handled by the image input and output apparatus in performing image input or output (see lines 36-41 of column 2 and figure 3); and

the image input and output control apparatus of claim 1 that transmits and receives data to and from each of the image input and output apparatus and the information terminal apparatus (see lines 36-41 of column 2 and figure 3).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumpf in view of Beach et al. (U.S. Patent No. 6,404,772 hereinafter "Beach").

5. Referring to claim 2, Kumpf fails to teach limitation of the second transmitting and receiving section that transmits and receives data wirelessly to and from a mobile information terminal apparatus.

Beach teaches a system comprising a transmitting and receiving section that transmits and receives data wirelessly to and from a mobile information terminal apparatus (see paragraph bridging columns 4 and 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Kumpf with the teachings of Beach such that the second transmitting and receiving section transmits and receives data wirelessly to and from a mobile information terminal apparatus. One of ordinary skill in the art would have been motivated to make such modification to increase the flexibility of the system to allow information terminals to be moved around freely as the user desires and to reduce the amount of wires and/or cables needed in the system.

6. Claims 3,5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumpf in view of Leiman et al. (U.S. Patent No. 6,469,796 hereinafter "Leiman").

7. Referring to claim 3, Kumpf fails to teach the image input and output control apparatus comprises a user interface providing section that provides a user interface relating to the image input and output apparatus, however Kumpf does disclose the image input and output control apparatus is a peripheral server (see item 10 in figure 1).

Leiman, in an analogous system, teaches a image input and output control apparatus comprising a user interface providing section that provides a user interface relating to the image input and output apparatus (see lines 23-26 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of Kumpf with the above teachings of Leiman. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to provide a user with a listing of currently pending jobs as suggested by Leiman (see lines 27-41 of column 2).

8. Referring to claim 5, Kumpf fails to disclose the image input and output control apparatus further comprising a billing apparatus that charges, in accordance with image input or output processing of the mage input and output apparatus, a user who has performed image input or output using the information terminal apparatus.

Leiman, in an analogous system, teaches a image input and output control apparatus comprising a billing apparatus that charges, in accordance with image input or output processing of the mage input and output apparatus, a user who has performed image input or output using the information terminal apparatus (see lines 20-34 of column 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of Kumpf with the above teachings of Leiman. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to keep track of which users are performing which activities using the image input and output apparatus.

9. Referring to claim 6, Kumpf fails to explicitly set forth the limitation the control section causes, in causing the data received by one of the first transmitting and receiving section

and the second transmitting and receiving section to be transmitted from the other, the data to be converted into a data format suitable for a transmission destination apparatus.

Leiman teaches, in an analogous system, the above limitation (see lines 54-64 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of Kumpf with the above teachings of Leiman. One of ordinary skill in the art would have been motivated to make such modification in order to put the data in a proper format for printing as suggested by Leiman (see lines 54-64 of column 2).

10. Claims 7,8,10,12,13,17-19,21,23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine et al. (U.S. Patent No. 6,020,973 herienafter "Levine") in view of Beach and Kawai et al. (U.S. Patent No. 6,513,073 hereinafter "Kawai").

11. Referring to claim 7, Levine teaches an image input and output control apparatus that receives printing data from an information terminal apparatus and transmits the printing data to an image input and output apparatus that prints out the printing data comprising:

a Web server that provides the information terminal apparatus with a user interface for setting a printing condition and instruction execution of printing through a Web browser (see paragraph bridging columns 9 and 10);

a controller that controls transmission of the received printing data including the printing condition set by the information terminal apparatus to the image input and output apparatus (see lines 1-12 of column 11);

a receiver that receives the printing data from the information terminal apparatus (see item labeled 201 in figure 5); and

a transmitter that transmits the printing data to the image input and output apparatus (see item labeled 208 in figure 5).

Levine fails to teach the receiver receives the printing data wirelessly from the information terminal apparatus.

Beach teaches, a system and method, wherein printing data is received wirelessly (see paragraph bridging columns 4 and 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Levine with the teachings of Beach such that the receiver of Levine is a wireless receiver. One of ordinary skill in the art would have been motivated to make such modification to increase the flexibility of the system by

allowing information terminals to be moved around freely as the user desires without being tethered by a cable and to reduce the amount of wires and/or cables needed in the system.

The combination of Levine and Beach fails to teach wherein the printing conditions including at least one of resolution density, color, sheet size, number of prints and file name.

Kawai teaches, in an analogous system, the above limitation (see line 44 of column 7 to line 2 of column 8).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Levine and Beach with the above teachings of Kawai. One of ordinary skill in the art would have been motivated to make such modification in order for the user to be able to specify how they want there documents processed.

12. Referring to claim 8, Levine teaches the control apparatus further comprises a memory that stores the received printing data (see lines 10-26 of column 13 and item labeled 204 in figure 5).

13. Referring to claim 10, Levine teaches the receiver and transmitter are isolated from each other physically (see items labeled 201 and 208 in figure 5).

14. Referring to claims 12 and 13, Levine teaches the receiver receives the printing data over a network from the information terminal apparatus and that the transmitter transmits the printing data over a network to the image input and output apparatus (see lines 40-54 of column 8).

15. Referring to claim 17, Levine teaches an image input and output control apparatus that receives first-format data from an information terminal apparatus and transmits second-format data to an image input and output apparatus that prints out the second-format data, comprising:

a Web server that provides the information terminal apparatus with a user interface for setting a printing condition and instruction execution of printing through a Web browser (see paragraph bridging columns 9 and 10);

a data converter that converts the received first-format data including the printing condition set by the information terminal apparatus into the second-format data which can be handled by the image input and output apparatus (see lines 40-55 of column 7);

a controller that controls transmission of the second-format data to the image input and output apparatus (see lines 1-12 of column 11);

a receiver that receives the printing data from the information terminal apparatus (see item labeled 201 in figure 5); and

a transmitter that transmits the printing data to the image input and output apparatus (see item labeled 208 in figure 5).

Levine fails to teach the receiver receives the printing data wirelessly from the information terminal apparatus.

Beach teaches, a system and method, wherein printing data is received wirelessly (see paragraph bridging columns 4 and 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Levine with the teachings of Beach such that the receiver of Levine is a wireless receiver. One of ordinary skill in the art would have been motivated to make such modification to increase the flexibility of the system by allowing information terminals to be moved around freely as the user desires without being tethered by a cable and to reduce the amount of wires and/or cables needed in the system.

The combination of Levine and Beach fails to teach wherein the printing conditions including at least one of resolution density, color, sheet size, number of prints and file name.

Kawai teaches, in an analogous system, the above limitation (see line 44 of column 7 to line 2 of column 8).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Levine and Beach with the above teachings of Kawai. One of ordinary skill in the art would have been motivated to make such modification in order for the user to be able to specify how they want there documents processed.

16. Referring to claim 18, Levine teaches the image input and output controller further comprises a memory that stores the received first-format data (see lines 41-65 of column 9).

17. Referring to claim 19, Levine teaches the image input and output control apparatus further comprises a memory to store the converted second-format data (see lines 41-65 of column 9; Note the ESS queue stores jobs until they are ready to be processed by the image input and output device).

18. Referring to claim 21, Levine discloses that the receiver and transmitter are isolated from each other physically (see items 201 and 208 in figure 5).

19. Referring to claims 23 and 24, Levine discloses the receiver receives the first-format data over a network from the information terminal apparatus and the transmitter transmits the second-format data over a network to the image input and output apparatus (see lines 15-40 of column 5).

20. Claims 16 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Beach as applied to claims 7 and 17 above, and further in view of Leiman.

21. Referring to claims 16 and 27, the combination of Levine and Beach fails to disclose the image input and output control apparatus further comprising a billing controller that calculates an amount of money to be charged based on a printing condition.

Leiman, in an analogous system, teaches an image input and output control apparatus comprising a billing controller that calculates an amount of money to be charged based on a printing condition (see lines 20-34 of column 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Levine and Beach with the above teachings of Leiman. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to keep track of which users are performing which activities using the image input and output apparatus and the amount they should be billed for the activities.

22. Claims 14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view Beach as applied to claims 7 and 17 and further in view of Kurachi (U.S. Patent No. 6,181,436).

23. Referring to claims 14 and 25, the combination of Levine and Beach fails to teach the limitation of the controller deleting the stored first-format data according to a user instruction after the printing has completed.

Kurachi teaches, in an analogous system, a controller deleting the stored first-format data according to a user instruction after the printing has completed (see paragraph bridging columns 8 and 9).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Levine and Beach with the above teachings of Kurachi. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to make room in the print queues when jobs are no longer needed to make room for new jobs being submitted.

24. Claims 15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view Beach as applied to claims 7 and 17 above and further in view of Mori (U.S. Patent No. 6,089,765).

25. Referring to claims 15 and 26, the combination of Levine and Beach fails to teach the limitation of the controller deleting the stored second-format data after a lapse of a prescribed time after the printing has completed.

Mori teaches, in an analogous system, a controller deleting the stored second-format data after a lapse of a prescribed time after the printing has completed (see lines 52-61 of column 7).

It would have been obvious to one of ordinary skill in the art the time of the applicant's invention to modify the combination of Levine and Beach with the above teachings of

Mori. One of ordinary skill in the art would have been motivated to make such modification in order to in order to allow new jobs to be recorded as suggested by Mori (see lines 52-61 of column 7).

Response to Arguments

26. Applicant's arguments filed 8/6/04 have been fully considered but they are not persuasive. The applicant argues:

1) that Kumpf does not teach a storage section that stores data received by one of the first transmitting and receiving section and the second transmitting and receiving section as recited in independent claim 1 (see second full paragraph of page 8 of applicant's remarks filed 8/6/04).

27. Applicant's remarks regarding claim 7 and 17 are rendered moot by the Examiner's new grounds of rejection.

As per argument 1, the Examiner disagrees. Firstly, the Examiner did not agree that Kumpf does not disclose at least a storage section that stores data received by one of the first transmitting and receiving section. The Examiner merely suggested adding ***all*** of the elements depicted in applicant's figure 2 and the associated connectivity (emphasis added). The

Examiner also informed the applicant that these suggestions were offered during the interview conducted 10/22/03. Lastly, Kumpf does teach a storage section for storing data received by one of the first transmitting and receiving section. At lines 25-38 of column 4, Kumpf teaches that if data is sent and the server determines that the appropriate channel is in a command mode, the data will be queued (stored) until the channel enters a data mode.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following reference are cited to further show the state of the art as it pertains to multi-functional peripheral (MFP) servers:

U.S. Patent No. 6,412,022 to Kumpf et al. teaches an MFP server comprising a storage element to store data received from one of a first and second transmitting and receiving section.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J Sorrell whose telephone number is 703 305-7800. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be

reached on 703 308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Effective October 13, 2004, the examiner can be reached at 571 272-4160, and the examiner's supervisor can be reached at 571 272-4146.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EJS
August 31, 2004

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